

FORM PTO 1390 (REV 5-93)		US DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTORNEY DOCKET NUMBER 2006 1381A
TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. §371			U.S. APPLICATION NO. (if known, see 37 CFR 1.52) NEW 10/593461
International Application No. PCT/EP2005/051241	International Filing Date March 17, 2005	Priority Date Claimed March 19, 2004	
Title of Invention ORGANIC COMPOUNDS			
Applicant(s) For DO/EO/US Peter HEROLD et al.			
Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:			
<p>1. <input checked="" type="checkbox"/> This is a FIRST submission of items concerning a filing under 35 U.S.C. §371.</p> <p>2. <input type="checkbox"/> This is a SECOND or SUBSEQUENT submission of items concerning a filing under 35 U.S.C. §371.</p> <p>3. <input checked="" type="checkbox"/> This express request to begin national examination procedures (35 U.S.C. §371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. §371(b) and PCT Articles 22 and 39(1).</p> <p>4. <input checked="" type="checkbox"/> A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.</p> <p>5. <input checked="" type="checkbox"/> A copy of the International Application as filed (in English) (35 U.S.C. §371(c)(2))</p> <p style="margin-left: 20px;">a. <input type="checkbox"/> is transmitted herewith (required only if not transmitted by the International Bureau).</p> <p style="margin-left: 20px;">b. <input checked="" type="checkbox"/> has been transmitted by the International Bureau.</p> <p style="margin-left: 20px;">c. <input type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US)</p> <p>6. <input type="checkbox"/> A translation of the International Application into English (35 U.S.C. §371(c)(2)).</p> <p>7. <input type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. §371(c)(3)).</p> <p style="margin-left: 20px;">a. <input type="checkbox"/> are transmitted herewith (required only if not transmitted by the International Bureau).</p> <p style="margin-left: 20px;">b. <input type="checkbox"/> have been transmitted by the International Bureau.</p> <p style="margin-left: 20px;">c. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired.</p> <p style="margin-left: 20px;">d. <input type="checkbox"/> have not been made and will not be made.</p> <p>8. <input type="checkbox"/> A translation of the amendments to the claims under PCT Article 19.</p> <p>9. <input checked="" type="checkbox"/> An oath or declaration of the inventor(s) (35 U.S.C. §371(c)(4)).</p> <p>10. <input type="checkbox"/> A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. §371(c)(5)).</p> <p>Items 11. to 14. below concern other document(s) or information included:</p> <p>11. <input checked="" type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98.</p> <p>12. <input checked="" type="checkbox"/> An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.</p> <p>13. <input checked="" type="checkbox"/> A FIRST preliminary amendment.</p> <p style="margin-left: 40px;"><input type="checkbox"/> A SECOND or SUBSEQUENT preliminary amendment.</p> <p>14. <input checked="" type="checkbox"/> Other items or information: (a) PCT Request; (b) Forms PCT/IB/306 (2) and 308; (c) published International application (WO 2005/090304) including International Search Report; (d) Solvias letter dated November 9, 2005 in response to Written Opinion with new set of claims 1-12 and pages with highlighted changes; and (e) International Preliminary Report on Patentability with amended sheets for claims 1-12.</p>			

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solvias ✓

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PCT patent application in the name of Speedel Experimenta AG
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Ladies and Gentlemen

Please find below the comments relating to the amendments and the Written Opinion to be taken into account for the international preliminary examination. The demand is filed herewith; see enclosures.

A new set of claims 1 to 12 is enclosed. Said claims shall form the basis of the further procedure. In order to address the criticism with regard to novelty (inventive step) and the clarity of the originally filed claims, the following amendments have been carried out:

- a) the term prodrug at the end of claim 1 has been further defined as "which, on *in vivo* application, release a compound of formula (I) by a chemical or physiological process," based on the disclosure page 21, first lines of second paragraph, in addition said definition was put first followed by the "isotopes" and finally the "salts".
- b) the expression "in particular" has been deleted at the end of claim 1;
- c) the compounds having as R6 a "polycyclic, unsaturated hydrocarbon radical", either substituted (option A) or unsubstituted (option B) have been deleted from claim 1 and made the object of a newly added independent claim 7;
- d) the remaining claims (original claims 7 to 11) have been renumbered (now 8 to 12) and the referrals of claims 10 to 12 include claim 7 whereas the referrals in claims 8 and 9 have been left unchanged.

The amendments to claim 1 (and the addition of new claim 7), as outlined above, exclude any generic overlap with the prior art cited for claims 1 to 6 and 8 to 12. It is therefore assumed that novelty and inventive step will be recognized for said claims.

10/593461

In view of the time constraints during the international phase, the Examiner is invited to discuss any remaining issue also by telephone or to issue an intermediate Official Action.

Very truly yours,



Dr. Paul Georg Maué
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Enclosures: Demand

Claims 1 to 12 (pages 74-85; in addition pages 77, 78, 81, 84
and 85 with changes highlighted)